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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,045	04/18/2001	Donald J. Mischo	MISCHO-1	2957

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KEITH FRANTZ  
401 WEST STATE STREET  
SUITE 200  
ROCKFORD, IL 61101

EXAMINER

SCHLAK, DANIEL K

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/838,045

Applicant(s)

MISCHO, DONALD J.

Examiner

Daniel K Schlak

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 10-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 10-44 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Election/Restrictions*

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 10-23 and 42, drawn to method and apparatus for shredding, separating, and sending fine and coarse material to different processing lines, classified in class 209, subclass 10.
- II. Claims 24-41, drawn to method for establishing target ratio and obtaining target ratio, classified in class 241, subclass 21.
- III. Claim 43, drawn to shredder and screen with established proportions of separated material, classified in class 241, subclass 79.
- IV. Claim 44, drawn to shredder and screen with defined cut-off point for screen, classified in class 241, subclass 79.

The Examiner notes at this point that the number of US Patents teaching methods comprising the combination of shredding and separating is in the tens of thousands. Of this group, those pertaining to asphalt likely number in the thousands. Thus, the claims are being treated as if the shredding and separating were standard, well-known and long-used process/aparatus concepts. Such as, there are entire subclasses (collections of art based upon common elements) at the PTO directed to separation in combination with comminution. In light of this, the actual inventions of the independent claims diverge from the outset. If shredding and separating are so

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commonly found together, then the recitation of such being in common among claims is not a sign of those claims standing or falling together in patentability in itself, but the subject matter found therewith may be.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as sending fine and coarse material to separate processing lines. Invention II has separate utility such as controlling a ratio to obtain a target ratio. See MPEP § 806.05(d).

Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it can be practiced without shredding to the range between 1 and 4 inches. It could be practiced with any number of maximum sizes below and above this range. The subcombination has separate utility such as establishing a 50-50 mix of fine to coarse and also in not sending to first and second processing lines. The subcombination would lose nothing of itself, as claimed,

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if the fines and coarse materials were, instead of being sent to different processing stations, re-mixed on the spot.

Inventions II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it can be practiced without shredding to the range between 1 and 4 inches. It could be practiced with any number of maximum sizes below and above this range. The subcombination has separate utility such as establishing a 50-50 mix of fine to coarse and also in not controlling the ratio to obtain a target ratio.

Inventions I and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it can be practiced without shredding to the range between 1 and 4 inches. It could be practiced with any number of maximum sizes below and above this range. The subcombination has separate utility such as establishing a cut-off size range of ½" to 1½" and also in not sending to first and second processing lines. The subcombination would lose nothing of itself, as claimed,

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if the fines and coarse materials were, instead of being sent to different processing stations, re-mixed on the spot.

Inventions II and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it can be practiced without shredding to the range between 1 and 4 inches. It could be practiced with any number of maximum sizes below and above this range. The subcombination has separate utility such as establishing a cut-off size range of ½" to 1½" and also in not controlling the ratio to obtain a target ratio.

Inventions III and IV are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention III has separate utility such as establishing a 50-50 mix by weight. Invention IV has a separate utility such as establishing a cut-off size range of ½" to 1½". See MPEP § 806.05(d).

Again, if it is foregone that methods and apparatus for shredding and separating of asphalt material are known and well-documented, then what remains of the independent claims is minimal, diverse among them, and hardly shows the four groups to be of the same inventive concept.

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Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II and vice versa, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group III or Group IV, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Group II is not required for Group III or Group IV, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the searches required for Group III and Group IV are not required in full for Group I or Group II, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel K Schlak whose telephone number is 703-305-0885. The examiner can normally be reached on Mon-Thurs.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald Walsh can be reached on 703-306 - 4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

dk

  
DONALD P. WALSH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600